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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/525,001

02/17/2005

Dieter Dorsch

MERCK-2974

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23599 7590 12/23/2008
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EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

12/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/525,001 | Applicant(s) DORSCH ET AL. | |
| | Examiner Laura L. Stockton | Art Unit 1626 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-51 is/are pending in the application.
- 4a) Of the above claim(s) 31-33, 36, 38, 39, 43-46, 49 and 50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 29,30,34,35,37,40-42,47,48 and 51 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 29-51 are pending in the application.

Election/Restrictions

Applicant's election with traverse of compounds where D is thiophenyl substituted by chlorine; R¹ is hydrogen; Y is Ar-diyl; T is 3-oxomorpholin-4-yl and W is acetamide in the replies filed on December 6, 2007 and March 19, 2008 was acknowledged in the previous Office Action. Applicant's election of compounds falls within Group II [products of formula I wherein D is thiophenyl, R¹ is hydrogen, Y is Ar-diyl, T is a heterocyclic, and W is - [C(R²)₂]_nCONR²[C(R²)₂]_n-] of the Restriction requirement dated November 30, 2007.

The requirement was deemed proper and therefore made FINAL in the previous Office Action.

Subject matter not embraced by Group II and Claims 31-33, 36, 38, 39, 43-46, 49 and 50 are withdrawn from

further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on March 19, 2008.

Rejections and objections made in the previous Office Action that do not appear below have been overcome by Applicant's amendments to the claims. Therefore, arguments pertaining to these objections and rejections will not be addressed.

Allowable Subject Matter

Claims 29, 30, 34, 35, 37, 40-42, 47, 48 and 51 are objected to as containing non-elected subject matter. Claims presented directed solely towards the subject matter of elected Group II would appear allowable over the art of record.

Response to Arguments

Applicant's arguments filed September 10, 2008 have been fully considered. Applicant has requested rejoinder of withdrawn process of making and using claims. In response, the subject matter of Group II was elected for examination in the instant application.

Group II is as follows: products of formula I wherein **D** is thiophenyl, **R¹** is hydrogen, **Y** is Ar-diyl, **T** is a heterocyclic, and **W** is $-[C(R^2)_2]_nCONR^2[C(R^2)_2]_n-$.

Although the elected invention of Group II is allowable, the product claims embracing the elected invention of Group II are not allowable because non-elected subject matter is present in these claims. Since the product claims are not allowable, the withdrawn process claims are not rejoined.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

This application contains subject matter not embraced by elected Group II and claims 31-33, 36, 38,

39, 43-46, 49 and 50 drawn to an invention nonelected with traverse in the reply filed on November 30, 2007. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

/Laura L. Stockton/

Laura L. Stockton

Primary Examiner, Art Unit 1626

Work Group 1620

Technology Center 1600

December 23, 2008